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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,561	03/04/2002	Basil Naji	BALDS2.024AUS	5549
20995	7590	12/23/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,561

Applicant(s)

NAJI ET AL.

Examiner

Paul Marcantoni

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1755

A1

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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Applicant's arguments filed 9/27/04 have been fully considered but they are not persuasive. The applicants' amendment necessitated the following new grounds of rejection. Further, additional references have been added which also teach the instant invention and were cited in an IDS (PTO-1449) at a time after the first office action. Thus, it is also noted that it is wholly proper to use these later cited references in a final rejection.

The applicant's amendment of claim 1 and 4 necessitated the following new grounds of rejection:

New Matter:

Claims 1-9 and 12 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The terms "said dewatering agent comprising fly ash of a larer size fraction and a smaller size fraction" is new matter. The applicants only have support for either a fly ash particle size range of from about 1 to 100 microns (p.5., paragraph 0032 of specification) and a preferred embodiment wherein fly ash comprises two components of which a larger size fraction has a 100 micron maximum size and the smaller size fraction is a range of about 10 micron maximum size. The specification requires that should applicants claim the preferred embodiment that they must also specify a particle size range (see p.5 specification, I paragraphs 32-33). Also, assuming this is the same preferred embodiment, the larger fly ash amount must be 10 to 60 wt% and the smaller fly ash fraction must be 5 to 30 wt% (see p.5 specification, paragraphs 34-35).

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Presently, applicants' claims do not have literal support for a larger and smaller particle size fraction from the original disclosure.

Claims 1-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "larger size fraction" and "smaller size fraction" are relative and indefinite terms because they do not particularly point out and distinctly claim the specific range of size for each fraction.

Claim 4 is now indefinite because it fails to further limit claim 1. Claim 1 now must be fly ash yet since it must be fly ash it cannot now also be alumina trihydrate, silica, flour, cenospheres, or mixtures thereof. The claim probably should have read further including instead of "selected from". It is also noted that in paragraph 17 of page 3 of the applicants' specification that there is no support for a mixture of these dewatering agents.

35 USC 102/103

Claims 1-9 and 12 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gleeson et al. '697 B2, Merkley et al. '745 B2, Duselis et al. '248 B1 or '146 B1, Brook et al. '310, Francis et al. '518, Styron '137 or '480 or '632, Brothers et al. '921, Kirkpatrick et al. '889 or '283, Onan et al. '521, Smetana et al. '255, Lowe '548, Wills Jr '316, Minnick '134 or

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'408, *RU 2157796 (Khrulev et al.-abstract only)*, *WO 97/21640 or PCT/US96/19936 (Liskowitz et al.)*, or *JP 60101074 (Matsushita-abstract only)*

Note: Italicized references from latest submitted PTO-1149.

All of the above cited references would appear to teach mixing compositions comprising cement, fly ash (dewatering agent), and water thus anticipating the instantly claimed invention (see respective claims for all patents above). Applicants' claimed process reads upon merely mixing cement, fly ash, and water which is old in the art. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

Obviousness Double Patenting:

Claims 1-9 and 12 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45, 1-52, 1-72, or 1-78 of U.S. Patent Nos. 6,572,697 B2 (Gleeson et al.), 6,676,745 B2 (Merkley et al.), 6,506,248 B1 (Duselis et al.), or 6,346,146 B1 (Duselis et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because all teach compositions comprising cement and fly ash and water in amounts overlapping the instantly claimed invention and process of making as well. Further, the assignee of James Hardie Research would appear the same for the instantly claimed invention and the patents above.

Response:

First, the Obviousness double patenting rejection cannot be held in abeyance as requested by applicants. Applicants must submit proper terminal disclaimers to overcome this rejection and the rejection will stand until this is carried out.

The applicants argue the 35 USC 102/103 art rejection by noting that none of the references teach a method of improving a coating by adding a dewatering agent to the coating mix and none of the prior art teach a dewatering agent of fly ash of two different size fractions. In rebuttal, the examiner respectfully disagrees. Fly ash collected from coal power plants normally fall in the range of 1 to 100 microns (see col.3, lines 4-5 of Francis et al. '518 and applicants' own specification which substantiates what is within the teaching of Francis et al. '518. The applicants' specification also teaches fly ash particles typically are in the range of about 1 to 100 microns. If this is so, then it is evident that more than one particle size range would be found in fly ash such as those of the prior art. As for the method of improving a coating by adding fly ash (ie "dewatering agent"), it is old or notoriously known in the art to add fly ash (which by its nature has a wide particle size range) to cement. It is also old in the art to use cement as a coating for building structures or to make an article such as a block or tile or foundation. Thus, the rejection over the prior art stands.

It is the examiner's position that the finality of this office action is now proper.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

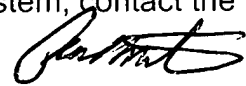
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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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